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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/192,583 11/17/98 MOTOYAMA T 5244-0084-2X

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EXAMINER

HO, C

ART UNIT

PAPER NUMBER

2757

DATE MAILED: 09/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/192,583

Applicant(s)
Motoyama

Examiner
Chuong Ho

Group Art Unit
2757



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19, 23-38, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwabara (U.S. Patent No. 6,065,183) in view of Forse'n (U.S. Patent No. 6,073,166).

In claims 1, 18, 23, 40, Kuwabara discloses a program for trouble shooting inspection is set in the form of electronic mail by the mail setting program and to User A through the Internet communication from the trouble diagnosing computer ; comprising:

- ♦ receiving an electronic mail message by a computer; determining whether the message which has been received is for a device associated with the computer (see col.5, lines 65-67, col.6, lines 1-22).

However, Kuwabara does not disclose transmitting a communication from the computer to the device, when the step of determining that the message is for the device.

Forse'n discloses module of executable code is derivable automatically for automatically starting the execution thereof together with the associated data when Internet Mail is read; comprising:

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- ♦ transmitting a communication from the computer to the device, when the step of determining that the message is for the device (see col.1, lines 10-24, lines 10-24, lines 30-35, col.2, lines 27-30, col.3, lines 1-2, lines 30-31, lines 42-45).

Given the teaching of Forse'n, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwabara's system to transmit a communication from the computer to the device, when the step of determining that the message is for the device because E-mail messages transmit from the computer which is attached to the device which include information regarding the status or capabilities of the device. Therefore, the attached file is an executable file which allows a user A ("clicking" or "double-clicking") to execute the program code contained within the attached file.

3. In claims 2, 24, Kuwabara discloses determining whether the message which has been received is for the device or whether the message which has been received has been received has a user of the computer as an end recipient (see col.5, lines 65-67, col.6, lines 1-22).

4. In claims 3, 25, Kuwabara discloses displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forward to the device, wherein the determining step comprises: determining by a user reading the message which has been displayed, whether the message which has been received is for the device (see col.5, lines 65-67, col.6, lines 1-22).

5. In claims 4, 5, 6, 7, 26, 27, 28, Forse'n discloses executing a command which causes the step of transmitting to be performed (see col.3, lines 30-32).

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6. In claims 6, 7, 9, 10, 19, 29, 31, 32, 41, Forse'n discloses executing the program code of the file by pointing, using a pointing device and a graphic user interface, to an object representing the file (see col. 1, lines 10-23, col.3, lines 1-3, lines 30-32).

7. In claims 8, 30, Forse'n discloses receiving an Internet electronic mail message (see col.1, line 67).

8. In claims 11, 33, Forse'n discloses performing a mechanical action by the device, in response to the communication which has been received by the device (see col.1, lines 10-23, col.3, lines 1-3, lines 30-32).

9. In claims 12, 13, 14, 15, 16, 34, 35, 36, 37, 38, Forse'n discloses determining that the message is for a device automatically by detecting a characteristic of the mail (see col.2, lines 27-31).

10. In claim 17, Kuwabara discloses the determining step is performed in response to a receipt of an incoming electronic mail message which is detected by monitoring an existence of a file stored at a predetermined location in memory (see col.5, lines 65-67, col.6, lines 1-22).

11. Claims 20, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Kuwabara and of Forse'n in view of Motoyama (U.S.Patent No.5,887,216).

In claims 20, 42, the combined system of Kuwabara and of Forse'n discloses the substantial features as claim 18.

The combined system of Kuwabara and of Forse'n discloses the computer is a message transfer agent, the step of transmitting information from the device transmits the information from

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the device directly to the computer which the message transfer agent (see Kuwabara, figure 1, col. 5, lines 65-67, col.6, lines 1-22).

However, the combined system of Kuwabara and of Forse'n does not disclose transmitting the electronic mail message transmits the electronic mail message using a TCP connection from the computer which is a message transfer agent.

Motoyama discloses transmitting the electronic mail message transmits the electronic mail message using a TCP connection from the computer which is a message transfer agent (see col.4, lines 43-50).

Given the teaching of Motoyama, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Kuwabara and of Forse'n to transmit the electronic mail message using a TCP connection from the computer which is a message transfer agent because the Internet system includes a plurality of interconnected computer and business office devices.

12. Claims 21-22, 39, 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Kuwaba, of Forse'n, and of Motoyama in view of Schreiber et al. (U.S. Patent No. 5,970,491).

In claims 21-22, 39, 43-44, the combined system of Kuwabara, of Forse'n and of Motoyama discloses the substantial features as claim 20.

However, the combined system of Kuwabara, of Forse'n, and of Motoyama does not disclose creating a file corresponding to the information; and writing the file to a mail spoon

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directory of the computer, and wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information using the file stored in the mail spoon directory.

Schreiber et al. discloses creating a file corresponding to the information; and writing the file to a mail spoon directory of the computer, and wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information using the file stored in the mail spoon directory (see abstract, see col.2, lines 60-67).

Given the teaching of Schreiber, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Kuwabara, of Forse'n and of Motoyama to create a file corresponding to the information; and write the file to a mail spoon directory of the computer, and wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information using the file stored in the mail spoon directory because from the message transfer agents 312, E-mail messages are stored in user mailboxes which are transferred to the user agent and ultimately transmitted to the user which functions as a receiving terminal.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong Ho whose telephone number is (703)306-4529. The examiner can normally be reached on Monday-Friday from 9am to 3pm.

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14. If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Burgess, Glenton, can be reached on (703)305-4792.

Any inquiry of a general nature or relating to the status of this application or proceeding should be direct to the group receptionist whose telephone number is (703) 305-3900.

CH

Date 09-22-00


ZARNI MAUNG
PRIMARY EXAMINER